

S/N 09/491,703

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Alex Dai-Shun Poon	Examiner:	Behrang Badli
Serial No.:	09/491,703	Group Art Unit:	3667
Filed:	January 26, 2000	Docket No.:	2043.007US1
Customer No.:	49845	Confirmation No.:	8953
Title:	METHOD AND APPARATUS FOR FACILITATING USER SELECTION OF A CATEGORY ITEM IN A TRANSACTION		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. An amendment is being submitted in a separate paper that complies with the requirements of 37 C.F.R. 41.33. Applicant requests that the Examiner admits this amendment because it complies with requirements of form expressly set forth in the "Claim Objections" section of the Office Action dated June 29, 2012 (hereinafter "*Office Action*"). This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below:

The Examiner rejected claims 9, 14, 15, 25, 30 31, 41, 46 and 47 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,397,221 issued to Greef et al. (hereinafter "*Greef*") in view of Official Notice taken by the Examiner "for a transaction to take place."¹ As the Supreme Court stated in *KSR Int'l Co. v. Teleflex Inc.*,² the factual inquiries announced in *Graham v. John Deere*³ (scope and content of the prior art; differences between the claimed invention and the prior art; level of ordinary skill in the art; and secondary indicia of non-obviousness), remain the foundation of any determination of obviousness.⁴ It remains true that "[t]he determination of obviousness is dependent on the facts of each case."⁵ Applicant

¹ *Office Action* at 3-4.

² *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

³ *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966).

⁴ See Examination Guidelines Update: Developments in the Obviousness Inquiry After *KSR v. Teleflex*, Federal Register / Vol. 75, No. 169 / Wednesday, September 1, 2010 / Notices, p. 53644 (hereinafter "2010 KSR Guidelines").

⁵ *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1089 (Fed. Cir. 2008) (citing *Graham*, 383 U.S. at 17-18 (1966)).

will show that, under the facts of this case, each of independent claims 9, 25, and 41, and their respective dependent claims, are patentable over *Greef* in view of the Official Notice taken by the Examiner.

Each of independent claims 9, 25, and 41, as amended, recites, in part,

providing a plurality of category entries to be displayed in a display window, said plurality of category entries being indicative of a categorization of a plurality of items that are available to be included in a computerized transaction;

detecting a selection of a category entry of said plurality of category entries in said display window;

in response to said detection of said selection of said category entry, providing a plurality of subcategory entries to be displayed in said display window, said plurality of subcategory entries being further indicative of said categorization of said plurality of items;

detecting a selection of a subcategory entry of said plurality of subcategory entries in said display window;

receiving a specification of a category number that uniquely identifies a combination of said category entry and said subcategory entry;

receiving an additional specification of said category number; and

based on said receiving of said additional specification of said category number—automatically reselecting said category and said subcategory in said display window.

Although *Greef* discusses a database that is “hierarchically arranged and presented” as “an alternative to relational databases”⁶ and that a “record identifier could be, for example, the tabular attribute model number, the model number for the product being an identifier likely to receive recognition across presentation formats,”⁷ *Greef* does not teach or suggest “receiving a specification of a category number that uniquely identifies a combination of [a] category entry and [a] subcategory entry,” as recited in each of independent claims 9, 25, and 41. Instead, *Greef* merely discusses “enables the user to select a tabular product attribute to act as general identifier for products in the hierarchical frame structure.” Here, the “model number” discussed in *Greef* is an example of one such tabular attribute. *Greef* does not teach or suggest that the “model number” (or any such tabular attribute for a product) identifies a combination of a category entry

⁶ *Greef* at col. 2, lines 61-67 and col. 3, lines 1-6.

⁷ *Greef* at col. 18, lines 42-46).

and a subcategory entry that was previously selected.

Additionally, *Greef* does not disclose "receiving an additional specification of said category number," much less "based on said receiving of said additional specification of said category number automatically reselecting said category and said subcategory in said display window," as recited in each of independent claims 9, 25, and 41.

The Examiner conceded that "*Greef* might not expressly disclose a transaction."⁸ The Examiner then stated that "since this is an e-commerce shopping system and method, a transaction is obviously present" and "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have a transaction take place per the Official Notice . . . because such a modification would allow *Greef* to have items to select from, prior to making a transaction."⁹ However, even if a transaction is obvious in view of *Greef*, which Applicant does not admit, no combination of *Greef* and the Official Notice teaches or suggests the elements of each of claims 9, 25, and 41 discussed above.

Furthermore, "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention."¹⁰ Here, *Greef* teaches away from Applicant's claims. In particular, *Greef* states the following:

Typically, product names, model numbers or other form of designators are disposed, in rows as record identifiers, followed by columns of product features; i.e., product attributes, which define the product, or vice versa, i.e., columns of product names and rows of attributes. As will be appreciated, to access a product record, commonly, either the user has to designate a product name, model number, or enter a descriptive, product-feature word strings to locate the product desired. However, such record access procedures are difficult for shoppers who don't know what model names or numbers to ask for, or who don't understand what features will be appropriate to put in a string search, or indeed, who don't really know what they are exactly looking for. And, as might be expected, this problem becomes even more difficult where the shopper spectrum includes individuals having different levels of product awareness, and diverse ages, educational, and community backgrounds. As will be appreciated, the less sophisticated the shoppers, the more difficult it is

⁸ Office Action at 6.

⁹ Office Action at 6-7.

¹⁰ *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); see also MPEP section 2141.02.IV.

for them to appreciate the search process, understand product jargon, and discriminate between product features.¹¹

Thus, *Greef* disparages the idea of using a number (e.g., a "model number") to locate a desired product, stating "[a]t the least, the approach of moving from category to subcategory and sub-subcategory avoids the risk of causing the uninitiated shopper to mistakenly compare apples and oranges when trying to make his purchase selection."¹²

In other words, *Greef*'s approach, which focuses on enabling the user to use generally understood categories and subcategories to find items, teaches away from, at least, the following elements of each of independent claims 9, 25, and 41:

receiving a specification of a category number that uniquely identifies a combination of said category entry and said subcategory entry;
receiving an additional specification of said category number; and
based on said receiving of said additional specification of said category number, automatically reselecting said category and said subcategory in said display window.

Many of the arguments presented above were set forth in the Office Action Response filed May 4, 2012. The Examiner did not directly address these arguments. Additionally, the Examiner appeared to rely on a combination of *Greef* and U.S. Patent Application Publication No. 2005/0071251 A1 to Linden et al (hereinafter "*Linden*") as allegedly teaching or suggesting various elements of independent claims 9, 25, and 41. However, the Examiner rejected independent claims 9, 25, and 41 as allegedly being unpatentable under *Greef* in view of Official Notice.¹³ The Examiner did not reject independent claims 9, 25, and 41 as being unpatentable under *Greef* in view of *Linden*. Thus, the Examiner was not only non-responsive, but also appears to have introduced a new ground for rejection that was not necessitated by Applicants' amendments. Reliance on a combination of references not cited on the Examiner's rejection of independent claims 9, 25, and 41 renders the finality of the *Office Action* improper.¹⁴

For the above reasons, Applicant respectfully requests that the Examiner withdraws the rejection of independent claims 9, 25, and 41, and their respective dependent claims, under 35

¹¹ *Greef* at col. 2, lines 40-60.

¹² *Greef* at col. 3, lines 2-7.

¹³ *Office Action* at 3.

¹⁴ See MPEP § 706.07(a).

U.S.C. § 103(a).

The Examiner rejected claims 16, 32, 48, 58, 59, 62, 63, 66, 67, 71, 73, and 75 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Greef* in view *Linden*. However, Applicants have canceled claims 58, 59, 62, 63, 66, and 67, rendering the Examiner's rejection of those claims moot. Furthermore, any claim depending from an allowable independent claim is also allowable.¹⁵ Therefore, claims 16, 32, 48, 71, 73, and 75 are patentable for at least the same reasons as discussed above with respect to the independent claims on which they depend. Additionally, each of these dependent claims may be patentable for its own reasons. Accordingly, Applicant respectfully requests that the Examiner withdraws the rejection of claims 16, 32, 48, 71, 73, and 75 under 35 U.S.C. § 103(a).

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to contact the undersigned representative by email (kiverson@slwip.com) or phone (408-660-2016) to facilitate prosecution of this application.

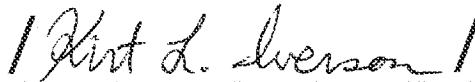
If necessary, please charge any additional fees or credit overpayment to Deposit Account 19-0743.

Respectfully submitted,

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¹⁵ See MPEP § 2143.03.